

REMARKS

The Examiner requires an election of Group I, claims 1-24 and 33-35, or Group II, claims 25-32 and 33-36 on the basis that they do not form a single general inventive concept under PCT Rule 13.1.

In response to the requirement for restriction, Applicants hereby elect Group I, directed to claims 1-24 and 33-35. Applicants respectfully traverse the requirement, however and request examination of claims 25-32 and 33-36 on the merits as well.

The Examiner also requires an election of species [a]-[u], recited in claims 4-24, if Group I has been elected.

In response to the requirement for election of species, Applicants hereby elect Species [m], claims 1-3, 33-35 and 16. Applicants respectfully traverse the requirement, and request examination of claims 4-15 and 16-24 on the merits.

Election of Group

No objection for lack of unity was made in the preliminary international examination in connection with the same claims that were presented in the corresponding PCT application. In examining all 36 claims, the Examiner obviously determined that at least one special technical feature was present, linking all of the claims.

According to the MPEP, "full faith and credit should be given to the search and action of a previous examiner unless there is clear error in the previous action" (MPEP § 706.04). Thus, the Examiner should give full faith and credit to the prior examination, finding unity of invention.

Aside from the foregoing, Applicant also submits that restriction is improper because the claims of Group I and II are directed to a single inventive concept, and share a corresponding special technical feature. PCT Rule 13, entitled "unity of invention," requires the claims in an international

application to be directed to a "single inventive concept." Claims of different categories are considered directed to a single inventive concept under PCT Rule 13.2, which states that unity of invention exists when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. Such features are defined in PCT Rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. Whether or not any particular technical feature makes a contribution over the prior art, and therefore constitutes a special technical feature, should be considered with respect to novelty and inventive step. See, MPEP §1850 ("DETERMINATION OF UNITY OF INVENTION"). "If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then there is unity of invention and an objection of lack of unity does not arise." (MPEP § 1850).

As stated in the International Preliminary Examination Report, the claims at issue were found to possess novelty and inventive step "because the prior art does not teach or fairly suggest a method for transferring a gene of interest having excisable flanking sequences from a first plant (a donor) transformed with said gene to a second plant of interest (a recipient), without movement of any native genomic DNA of the donor." This technical feature clearly makes a contribution over the prior art and meets the criteria of a special technical feature as defined in the Rule. This feature is present in all 36 claims; in Group I the unstable hybrid is achieved on a plant level, whereas in Group II it is first produced on a protoplast level.

Here again, the Examiner should give full faith and credit to the findings of the previous Examiner during prosecution of the PCT application, at least to the extent that the current

Examiner should find that all 36 claims have a common special technical feature, possessing unity of invention.

In support of her allegation that the claims lack unity of invention, the Examiner believes various claims lack novelty over *Hadley et al.* (1980, Am. Soc. Of Agronomy, Madison p. 133-134) ("Hadley"). Applicants disagree. *Hadley* does not teach the use of transgenic plants crossed with another plant to produce an unstable hybrid. *Hadley* describes the chromosomal DNA introgression of one plant species into another whereby the native genomic DNA of the donor is also transferred. (*Hadley*, p. 134).¹ In the claimed invention, the transgene flow that takes place between the donor and the acceptor plant species involves a transgene with which the donor plant species had been transformed. There is no such teaching in *Hadley*.

For the above-mentioned reasons, the proper conclusion is the claims possess unity of invention because they share a special technical feature and form a single general inventive concept that distinguishes over the prior art.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the restriction, or modification of the requirement by joining Group II (claims 25-32 and 33-36) with Group I (claims 1-24 and 33-35).

Election of Species

The Examiner's restriction of species is improper for the same reasons set forth above. All of the various dependent claims, by definition, possess the same single inventive concept or corresponding technical feature found in the independent claim. Accordingly, Applicants respectfully request reconsideration and withdrawal of the election of species requirement as well.

¹ To the best of applicant's knowledge, the technology needed to create transgenic plants was not developed until 1983, three years after the *Hadley* publication. (See *Fraley et al.*, Proc. Natl. Acad. Sci. USA, 1983, 80:4803-4807; *Shaw et al.*, Gene, 1983, 23:315-330).

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone applicants' attorney at (908) 654-5000 in order to overcome any additional objections which the Examiner might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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